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ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA, PA 19103

EXAMINER

NELSON, MICHAEL B

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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02/05/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

Response to Arguments

1. Applicant's arguments and the affidavit of 01/26/10 have been considered but are not found to be persuasive.

2. Applicant argues that it would not have been obvious to have optimized the layer of Sadamitsu to arrive at the instantly claimed cushioning factor. First, applicant stressed that the Sadamitsu reference does not explicitly mention the words "cushioning factor." The examiner notes that just because a prior art does not mention the exact same instantly claimed property would not make it non-obvious for one having ordinary skill to have adjusted the physical properties to arrive at the claimed property. In this case, "cushioning factor" appears to be some measurement of a film's ability to respond to force (Affidavit, page 6). The examiner notes that at [0034] Sadamitsu discloses tensile strength as a parameter that would be controlled by one having ordinary skill in the art as being dependent on the porosity or void volume of the porous film. The tensile strength disclosed in Sadamitsu is related to what applicant refers to as "cushioning factor." Furthermore, and more to the point, Sadamitsu is not being used alone but is combined with Asakura. Asakura discloses that it is advantageous to increase the cushioning rate above 8% (last paragraph of page 9). Hence one having ordinary skill, with both Sadamitsu and Asakura before them, would find it obvious to have adjusted the porosity of the film of Sadamitsu, which affects the tensile strength, to arrive at the cushioning factor of Asakura. Therefore, it would have been obvious to have modified the porous film of Sadamitsu, used in the layered film of Asakura, to have the instantly claimed cushioning factor.

3. Applicant has also submitted an affidavit comparing one example from Sadamitsu with the instantly claimed invention. The examiner does not find that the affidavit presents sufficient

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evidence of unexpected results. The affidavit compares only one example of Sadamitsu to one example of the instantly claimed invention. The examiner notes however, that the one example from Sadamitsu is not indicative of the range of porosities (and therefore implicit cushioning factors) disclosed in Sadamitsu. The example used from Sadamitsu has porosities which are quite different from the example from the instant specification; However, Sadamitsu discloses that porosities overlapping those of the example from the instant specification were desirable. See [[0031]-[0032]. Sadamitsu discloses Average pore sizes (under both the BP and mercury methods) which overlap those of the instant example (i.e. 0.04-0.06 and 0.1-0.50 microns). Also Sadamitsu discloses that the maximum pore size in the thickness direction should range from 0.1-5 microns and 1-50 microns in the longitudinal and transverse directions (i.e. the direction perpendicular to the thickness directions). Therefore the porosity ranges taught by Sadamitsu would appear to encompass porosities which would exhibit the claimed cushioning factor and given the motivation to optimize the cushioning factor (from both Sadamitsu and Asakura) it would have been obvious to have arrived at the instant inventive cushioning factor.

4. For applicant to show an unexpectedly beneficial cushioning factor at certain porosities, evidence must be presented showing that arriving at the instant cushioning factors, from the ranges of porosities of Sadamitsu, would have been unexpected and non-obvious, even in light of the teaching of Asakura towards maximizing the cushioning factor.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571) 270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794

/MN/
01/29/10